



MAILSTOP: APPEAL BRIEF - PATENTS

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : O. C. Huse
Appl. No. : 09/904,468
Filed : July 13 2001
Title : FUEL TANK HAVING MOLDED REINFORCEMENTS
AND METHOD OF MAKING SAME

Grp./A.U. : 1772
Examiner : Marc A. Patterson

Docket No. : 64294-034

TRANSMITTAL OF APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

MAILSTOP: APPEAL BRIEF - PATENTS

Dear Sir:


Applicant submits the attached Appeal Brief in response to the Official Action dated November 1, 2004. A check in the amount of \$ 500.00 is attached to cover the required fee for submitting this Appeal Brief. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 08-2789. A duplicate copy of this letter is enclosed herewith.

Respectfully submitted,

HOWARD & HOWARD ATTORNEYS, P.C.

January 26, 2005

Date

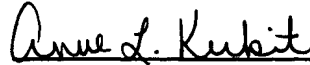

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MAILSTOP: APPEAL BRIEF - PATENTS

CERTIFICATE OF MAILING

I hereby certify that the attached Appeal Brief for application serial number **09/904,468** filed **July 13, 2001** is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to the **Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450** on this **January 26, 2005**.



Anne L. Kubit



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Appl. No. : 09/904,468
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BRIEF ON APPEAL

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450
MAILSTOP: APPEAL BREIF

Applicant submits the following arguments in support of this appeal in response to the Final Rejection set forth in the Official Action dated November 1, 2004.

(1) Real Party in Interest

This application was assigned by the inventorship to The Moore Company, as evidenced by the assignment recorded on May 29, 1998 on reel 009411 and located at frame 0669.

(2) Related Appeals and Interferences

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(3) Status of Claims

Claims 1, 3, 6 and 7 are on appeal and are attached hereto in the appendix.

(4) Status of Amendments

All amendments have been entered and are reflected in the claims in the Appendix.

(5) Summary of Claimed Subject Matter

Independent claim 1 recites a container body (22) formed of a thermoplastic material (page 3, lines 15-16) having at least three sides with an inner surface, an outer surface, and at least one corner (32) joining the three sides. A reinforcement (40) of thermoplastic material is disposed over the outer surface of the three sides of the corner (32) (page 4, lines 23-25) and includes a bottom surface (45) and a top surface (34) (page 5, lines 4-7) tapering (page 4, line 31) to a peripheral pointed edge (44) extending completely about the corner reinforcement. The thermoplastic material of the container body (22) is disposed over the pointed edge (44) to engage the tapered bottom (45) and top (34) surfaces completely about the peripheral edge for mechanically locking the reinforcement (40) to the container body (22) on all three sides thereof while exposing the top surface (34) of the reinforcement (40) (page 5, lines 1-8).

(6) Grounds of Rejection to be Reviewed on Appeal

Independent claim 1 and dependent claims 3, 6 and 7 are rejected under 35 U.S. C. Section 103(a) as being unpatentable over the patent 4,207,284 to Speas. For the purposes of this appeal, the patentability of dependent claims 3, 6 and 7 will reside in the

patentability of claim 1.

(7) Argument

The Speas '284 patent discloses a corner insert 210 for a fifty-five gallon type drum to present a protrusion 216 for lifting the drum, as illustrated in Figures 9 & 10. As explained in col. 6, lines 54-65 in connection with Figure 8, the thermoplastic of the drum is prevented from surrounding the edges of the insert **210**. In contradistinction, claim 1 recites that thermoplastic material of the container body **(22)** is disposed over the pointed edge **(44)** to engage the tapered bottom **(45)** and top **(34)** surfaces *completely about the peripheral edge* for mechanically locking the reinforcement **(40)** to the container body **(22)** on all three sides thereof while exposing the top surface **(34)** of the reinforcement **(40)**. Figure 19 in the Speas '284 patent merely shows a lid 421 extending at 425 over the protrusion 416 of the insert and locked into position by a locking ring 432. Again, the insert of Speas '284 does not extend about three sides of a corner with the container body **(22)** disposed over the pointed edge **(44)** to engage the tapered bottom **(45)** and top **(34)** surfaces *completely about the peripheral edge*. This is clear at 413 in Figure 19 of Speas '284 and in col. 12, lines 12-15 where it is recited that the "edges 412 and 413 . . . are angled to fit flush with the corresponding walls of the mold cavity . . ."

The examiner admits that Speas '284 "fails to disclose a reinforcement . . . having a pointed edge extending completely about the reinforcement." However, Speas '284 teaches directly the opposite, to wit; that the edges be flush with the container walls. The courts have long held that there must be some motivation for an artisan to make the

edges of Speas ‘284 pointed, but to make the edges of Speas ‘284 pointed would be contrary to the teachings of Speas ‘284 wherein it is desirable to make the edges flush with the container walls to prevent leakage of container plastic into the corner. This is directly opposite to applicant’s claim wherein it is desirable for the container plastic to leak around the pointed edge of the insert. This is not a mere change in shape, as the examiner suggests, it is shape with a purpose and a result, Applicant’s result being much different than that in Speas ‘284.

The examiner also admits that Speas ‘284 fails to disclose a reinforcement “disposed over the outer surface of three sides of a corner.” As clearly illustrated in Figures 14 – 18 of Speas ‘284, the insert is generally planar and arcuate to extend about a portion of the circumference of the drum as the drum is formed by the insert completely covering and filling the corner of the mold. There is absolutely no suggestion of a three sided corner with an insert embedded in the corner as claimed in claim 1. The courts have stated that the temptation to engage in impermissible hindsight is especially strong with seemingly simple mechanical inventions.

The deficiencies in the prior art can not be overcome by mere conclusions without a proper analysis meeting the requisite teaching-suggestion-motivation test.

The law is adequately set forth in the MPEP:

2143.03 All Claim Limitations Must Be Taught or Suggested [R-1]

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). If an independent

claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837, F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

2142 Legal Concept of Prima Facie Obviousness [R-1]

. . . The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness . . .

ESTABLISHING A *PRIMA FACIE* CASE OF OBVIOUSNESS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not be based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP §243 - §2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

The law is adequately set forth in the MPEP:

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It is respectfully submitted that the examiner's analysis failed to apply the requisite teaching-suggestion-motivation test in rejecting the claims. Accordingly, the reversal of the rejection of claims 1, 3, 6 and 7 be reversed.

The reversal of the rejection of claims 1, 3, 6 and 7 is respectfully solicited.

Respectfully submitted

HOWARD & HOWARD ATTORNEYS, P.C.

January 26, 2005

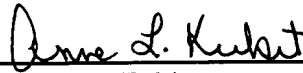
Date

A handwritten signature in dark ink, appearing to read "Harold W. Milton, Jr.", is written over a horizontal line.

Harold W. Milton, Jr., Registration No. 22,180
The Pinehurst Office Center, Suite #101
39400 Woodward Avenue
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A handwritten signature in cursive script, reading "Anne L. Kubit", is written over a solid horizontal line.

Anne L. Kubit

(8) Claim Appendix

1. A container body formed of a thermoplastic material having at least three sides with an inner surface, an outer surface, and at least one corner joining said three sides, a reinforcement of thermoplastic material disposed over said outer surface of said three sides of said corner, said reinforcement having a bottom surface and a top surface tapering to a peripheral pointed edge extending completely about said corner reinforcement, said thermoplastic material of said container body being disposed over said pointed edge to engage said tapered bottom and top surfaces completely about said peripheral edge for mechanically locking said reinforcement to said container body on all three sides thereof while exposing said top surface of said reinforcement.

Claim 2 (Cancelled)

3. A container assembly as set forth in claim 1 wherein said peripheral edge is cohesively bonded to said outer surface of said container body.

Claims 4-5 (Cancelled)

6. A container assembly as set forth in claim 1, wherein the thermoplastic material comprising said container assembly is polyethylene.

7. A container assembly as set forth in claim 1, wherein said reinforcement includes a vent hole therethrough for venting fluid between said container body and said reinforcement.

Claims 8-22 (Cancelled)